IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John C. Harvey and James W. Cuddihy:

Group Art Unit: 2737

Serial No.:

08/470,571

Examiner: FAILE, A.

Filed:

June 6, 1995

Atty. Docket: 05634.0261

For: SIGNAL PROCESSING APPARATUS

AND METHODS

TRANSMITTAL LETTER

BOX: NON-FEE AMENDMENT

Assistant Commissioner of Patents Washington, D.C. 20231

[X] Amendment under 37 C.F.R. § 1.115

Request for Extension of Time Pursuant to 37 C.F.R. § 1.136(a) [X]

An additional claim fee is required, and is calculated as shown below: []

	(Col 1)	_	(Col 2)	(Col 3)		
	Claims Remaining After Amendment		Highest No. Previously Paid for	Present Extra	Rate	Additional Fee
Total	*127	Minus	**127	=0	x \$ 18.00	\$0.00
Indep.	*18	Minus	***18	=0	x \$ 78.00	\$0.00
First Presentation of Mult. Dep. Claim					x \$ 260.00	\$0.00
Total Add	\$380.00					
Total Fee	Enclosed					\$380.00

If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

If the "Highest Number Previously Paid For" in this space is less than 20, write "20" in this space.

If the "Highest Number Previously Paid For" in this space is less than 3, write "3" in this space. "The Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

Hunton & Williams check no. <u>2040668</u> in the amount of \$380.00 is enclosed. [X]

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment [X]to Deposit Account No. 50-0206.

> Any filing fees under 37 CFR 1.16 for the presentation of extra claims. [x]

[x]Any patent application processing fees under 37 CFR 1.17.

Date: <u>June 7, 2000</u>

HUNTON & WILLIAMS

1900 K Street, N.W.

12th Floor

Washington, D.C. 20006

Respectfully submitted

Thomas J. Scott, Jr.

Reg. No. 27,836 Donald J. Lecher

Reg. No. 41,933

Attorneys for Applicants

Tel: (202) 955-1938

Serial No. 08/470,571 Docket No. 05634.0261

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of

John C. Harvey and James W. Cuddihy

Examiner:

LUTHER, W.

Serial No.

08/470,571

Group Art Unit:

2742

Filed:

June 6, 1995

Atty. Docket.

05634.0261

For: SIGNAL PROCESSING APPARATUS

AND METHODS

BOX: FEE AMENDMENT

Assistant Commissioner of Patents and Trademarks Washington, D.C. 20231

JUN - 7 2000 TECH CENTER 270

AMENDMENT AND REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.111

Table of Contents

I.	AMENDMENTS	4
Α	. TO THE SPECIFICATION	1
В	. TO THE CLAIMS	4
II.	REMARKS	
Α	. Introduction	42
	1. Claim Accounting	42
	2. Summary of Jan. 7, 2000 Office Action rejections	43
В	. SUMMARY OF AMENDMENTS	45
С	STATEMENT OF PATENTABLE NOVELTY UNDER 37 C.F.R. § 1.111	55
D	RESPONSE TO INTERVIEW SUMMARY OF JAN. 6, 2000	63
E	. RESPONSE TO OBJECTION TO THE SPECIFICATION	. 64
	1. Amendment of March 4, 1999	64
	2. Amendment of June 6, 1995	66
F.	TEST ONES TO TEST ON OF DEFECTIVE OATH/DECLARATION	66
G	RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 112	67
	1. Response to Rejections under §112, first paragraph	67
	a) Response to Written Description Rejections	67
	(1) The Office Action Fails to Establish a Prima Facie Rejection Under the Written Description	
	Requirement of 35 U.S.C. § 112	67
	(2) The PTO's Requested Process for Successfully Traversing the Written Description Rejection is Required by 35 U.S.C. § 112	Not
	(a) 35 U.S.C. § 112 Includes No Requirement That the Entire Support for Each Individual Clair	/U
	Must Come From Within a Single Detailed Example Described in the Specification	71
	(i) "One Combined Medium" (pages 19-28)	73
	,	

(ii) "The Signal Processor" through "The Normal Transmission Location" (pages 28-86) at	nd "The
Preferred Configuration of Controller, 39, and SPAM-Controller, 205C." (pages 156-162)	76
(iii) "Operating Signal Processor Systems Introduction" through "Operating Signal Processor Systems	cessor
Systems Signal Record Transfer" (pages 86-278)	76
(iv) "Regulating the Reception and Use of Programming including Example #6" and "	. Example
#7" (pages 278-312) as well as " More on Example #7 Combining Automatically to the	ie
Computer System" (pages 427-447)	78
(v) "Monitoring Receiver Station Reception and Operation" (pages 312-324)	79
(vi) "Automating Intermediate Transmission Stations" (pages 324-390) including "Example	le #8"
(pages 340-354)	80
(vii) Examples #9 and #10 (pages 354-390 & 469-516): "Automating Intermediate Sta	tion
Combined Medium Operations" (pages 354-374 of Example #9) and "Network Control of	
Intermediate Generating and Embedding" (pages 374-390 of Example #10)	81
(viii) Automating Ultimate Receiver Stations (pages 390-427) Regulating Station Environment	onment
(pages 396-406) Coordinating a Stereo Simulcast (pages 406-419) Receiving Selected	
Programming (419-427)	83
(ix) More Disclosure in the Context of "Wall Street Week" (pages 427-469)	84
(a) More on Example #7 (pages 427-447)	84
(b) Controlling Combined Medium Operations (pages 447-457)	85
(c) Transmitting Program Instructions Sets (pages 457-463)	86
(x) Audio Overlays and Other Overlays (pages 463-468)	86
(xi) Examples #9 and #10 Continued – Viewer/Listener Station Functionalities (pages 469)	-516) 86
(xii) Preprogramming Receiver Station Operating Systems (pages 516-532) and The Prefer	rred
SPAM Header (pages 532-533)	87
(xiii) The General Case Summary Example #11 (pages 533-557)	87
(xiv) Conclusion	88
(b) The Subject Matter in the '81 Disclosure is Specifically Included In the Instant Specific	ation 90
(c) 35 U.S.C. § 112 Includes No Requirement That Identical Embodiments of the Invention	n he
Described in Both a Parent Application and a Subsequent Application Claiming Priority Therefi	rom 92
(3) Conclusion	94
b) The Specification Enables One Skilled in the Art to Make and Use the Invention	95
(1) "Digital" is Enabled by the Specification	96
(2) "Data" is Enabled by the Specification	98
c) The Best Mode of Practicing the Claimed Invention Contemplated by Applicants is Disclosed in	n the
Specification	101
2. The Claims Comply With 35 U.S.C. § 112, second paragraph	105
a) The Claims Define That Which Applicants Regard as Their Invention	106
b) "Use" Language Fails to Render a Claim Indefinite	107
c) There is no discrepancy in the use of the term "Programming"	108
d) There is no discrepancy in the use of the term "Information"	111
e) There is no discrepancy in the use of the terms "Conjunction," "Combine," and "Combined"	112
H. RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 102	113
1. Rejection under 102 (b) over Applicants' U.S. Pat. Nos. '490 & '725	112
2. Rejection under 102 (a, b & e) over Campbell et al., U.S. Pat. No. '791	113
a) Summary of Office Action's Rejection Over Campbell et al.	114
b) Characterization of Campbell et al.	114
c) Applicants' Claim 56	127
d) Applicants' Claim 75	128
e) Applicants' Claim 80	127
f) Applicants' Claim 84	122
g) Applicants' Claim 93	132
h) Applicants' Claim 110	133
i) Applicants' Claim 116	125
j) Applicants' Claim 123	133 21
k) Applicants' Claim 142	130 127
l) Applicants' Claim 143	13/ 120
m) Applicants' Claim 152	138 120
n) Applicants' Claim 157	120
o) Applicants' Claim 162	139
p) Applicants' Claim 167	140
	141

q) Applicants' Claim 171	142
r) Applicants' Claim 175	143
s) Applicants' Claim 177	144
t) Applicants' Claim 179	145
u) Summary	146
3. Rejection under 102(e) over Jeffers et al., U.S. Pat. No. '510	.146
I. RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 103	147
1. Rejection over Campbell et al. or Jeffers et al. in view of Applicants' U.S. Pat. Nos. '490 & "	.17 <i>1</i> 725 14
2. Rejection over WO 89/02682	23.14
2. Rejection over WO 69/02/02/	.147
3. Rejection over Campbell et al., U.S. Pat. No. 4,536,791	.148
a) Applicants' Claim 56	149
b) Applicants' Claim 75	150
c) Applicants' Claim 80	152
d) Applicants' Claim 84	152
e) Applicants' Claim 93	153
f) Applicants' Claim 110	154
g) Applicants' Claim 116	155
h) Applicants' Claim 123	156
i) Applicants' Claim 142	157
j) Applicants' Claim 143	158
k) Applicants' Claim 152	159
l) Applicants' Claim 157	160
m) Applicants' Claim 162	160
n) Applicants' Claim 167	161
o) Applicants' Claim 171	162
p) Applicants' Claim 175	164
q) Applicants' Claim 177	165
r) Applicants' Claim 179	165
4. Rejection over Jeffers et al	167
5. Rejection over Jeffers et al. in view of Examiner's Official Notice.	167
6. Rejection over Campbell et al. in view of Zaboklicki.	160
7. Rejection over Jeffers et al. in view of Zaboklicki.	.100
j	.1/4
The state of the English text of Administrative Regulation	174
K. RESPONSE TO OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION	175
1. PTO Assertions in Office Action mailed January 7, 2000	176
2. The Scope of the Double Patenting Doctrine	177
3. Patent Office Procedure	178
4. Nonstatutory Double Patenting	179
a) Standard for Determining One-Way Obviousness-Type Double Patenting	180
(1) Identifying the Inventions Claimed	181
(a) Scope of the Inventions as Defined by the Claim Language	181
(b) Proper Use of Specification	183
(c) Best Mode	186
(d) Means Plus Function	187
(2) Establishing Variations between the Invention Claimed and the Invention Defined in the Paten	t
Claims 188	
(3) Variations Would Have Been Obvious to a Person of Ordinary Skill in the Art	189
5. Conclusion	193
III. CONCLUSION	194
APPENDIX A: Specification Support to Parent 1981 Application and the Instant Application.	
APPENDIX B: Patentable Subject Matter of Instant Claims over Applicants' Patented Claims.	
APPENDIX C: Correlation Charts between the Parent 1981 Specification and the Instant 1987 Priorit	C)
	у
Specification	
APPENDIX D: Glossary of Defined Terms to the Instant 1987 Priority Specification	

I. AMENDMENTS

The amendments set forth below are made in response to the Non-Final Office Action initially mailed October 17, 1999, and supplemented with a fully substituted Non-Final Office Action on January 7, 2000. Applicants respectfully request that the Examiner enter the following amendments in the above-captioned application and reconsider the allowability of the application as amended under 37 C.F.R. § 1.111.

A. To the Specification

Applicants request entering the below amendments to the specification.

On page 1, in the paragraph entitled, "Cross-Reference to Related Applications," on the second line, please delete:

"herein incorporated by reference in its entirety".

This text was mistakenly presented in the statement of the chain of priority of the application under 35 U.S.C. § 120. The statement is surplusage as the specification of Application Number 08/113,329 is the identical specification to that of the instant application.

B. To the Claims

Applicants request that the Examiner enter the amendments to the claims set forth below. Claims 56, 58, 60, 65-67, 69, 72, 73, 75-79, 81, 82, 86, 88, 93, 96, 102, 104-107, 109, 112, 113, 116, 117, 122-124, 126-135, 139-143, 147, 149-153, 155, 158, 161, 162, 164-166, 171, and 175 are amended. For the PTO's convenience, claims that remain unchanged are included below in order to allow the Examiner to review all pending claims from this response in their numerical order.

56. (Four Times Amended) A method for receiving and processing data for use with an interactive video apparatus, said interactive video apparatus having a